

### Remarks

Claims 1-20 are now pending in this application. In the December 3, 2003 Office Action, claims 9 and 20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Claims 1 and 9-20 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1 and 9-11 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,070,150 to Remington et al. (hereinafter "*Remington*"). Claims 2-8 and 12-20 were rejected under 35 U.S.C. § 103(a) as being obvious over *Remington* in view of U.S. Patent No. 6,026,370 to Jermyn (hereinafter "*Jermyn*"). The applicants have amended claims 1, 4, 9-10, and 19-20 and canceled claims 2-3, 5-6, 14, and 16-17. For the reasons set forth below, the applicants respectfully request reconsideration and immediate allowance of this application. Prior to discussing the reasons why the applicants believe that the claims currently pending in this application are allowable, a brief description of the present invention and the cited reference is presented.

### Summary of the Invention

The present invention provides a method and system for communicating with customers in which pre-selected non-billing information is combined with a customer's billing information to create a customized communication. According to one embodiment, the invention employs a computer database and a set of classifications that are correlated to customer traits. The classifications are assigned to customers, and recorded with the customer profiles in the database. Non-billing information is classified according to the same set of classifications to form non-billing information profiles, which are also stored in the database. The database also contains billing information for the customers. The billing information for a customer is combined with any non-billing information that has a classification matching a classification assigned to the customer. This combined billing information and targeted non-billing information is conveyed to the customer as a customized communication.

Summary of the Cited Reference

*Remington* describes an electronic bill presentment and payment system. The system is configured for use over the Internet. According to this system, a biller may create an electronic bill and forward it electronically over the Internet to a consumer. The consumer may challenge portions of the bill according to predefined dispute reasons and may authorize partial or full payment. The remittance is transmitted electronically back over the Internet to the biller where payment instructions are then forwarded by the biller from the consumer to the biller's bank. Although *Remington* describes optional inclusion of third-party advertising, as will be discussed below, *Remington* does not teach, suggest, or describe presenting the customer with information that is specific to the customer's traits.

*Jermyn* describes a technique for customizing mailed purchase incentives to customers. *Jermyn* teaches searching a purchase history database of consumers for those consumers that have purchased items relating to a particular brand of product or category of product in which the brand belongs. That group of consumers is then sent one of three incentives based on a determination as to whether they are loyal to the promoted brand, loyal to a competitive brand, or new to the selected product group. The process begins with a targeted product category and results in targeted advertising being sent to a group of consumers who have purchased products within that category.

Claim Rejections - 35 U.S.C. §112

Claims 9 and 20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. The applicants have amended claims 9, 19, and 20 to provide proper antecedent basis.

Claim Rejections - 35 U.S.C. §101

Claims 1 and 9-20 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1 and 10 have been amended. The applicants submit that amended independent claims 1 and 10, and consequently dependent claims 9 and 11-20, are directed to patentable subject matter.

Claim Rejections - 35 U.S.C. §102(b) and §103(a)Independent Claim 1

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by *Remington*. *Remington* does not teach, suggest, or describe each recitation of amended independent claim 1. In particular, *Remington* does not teach “wherein the stored customer profiles and non-billing information profiles each comprise an identical set of classifications based on customer traits” and “selecting non-billing information related to the customer from a non-billing information profile according to a set of classifications stored in the non-billing information profile that is identical to a set of classifications stored in a customer profile corresponding to the customer.”

*Remington* teaches including non-billing information with a bill, but does not teach customizing the non-billing information to the specific customer. *Remington* does not teach a set of classifications stored in a non-billing information profile. As acknowledged by the Examiner on page 4 of the December 3, 2003 Office Action “*Remington et al.* does not teach: classifying the customers in the database comprising creating a set of classifications that correlate to customer traits and assigning classifications to customers; classifying the non-billing information in the database comprising assigning classifications to non-billing information; [and] combining billing information and non-billing information based on classification matches.” Accordingly, independent claim 1 is allowable over *Remington*.

Additionally, the applicants submit that amended independent claim 1 is not obvious in view of *Jermyn*. *Jermyn* also fails to teach, suggest, or describe the recitations of claim 1. *Jermyn* teaches conveying non-billing information to a customer. This information is in the form of incentives and related mailing material. Claim 1 of the present invention recites “selecting non-billing information related to the customer from a non-billing information profile according to a set of classifications stored in the non-billing information profile that is identical to a set of classifications stored in a customer profile corresponding to the customer.” The incentives of *Jermyn* are not stored as a profile in a database along with a set of classifications that are identical to a set of classifications stored in a customer profile, as is recited by claim 1 of the present invention. Rather, customers are matched to incentives based on a determination as to their brand loyalty.

*Jermyn* teaches determining a measure of loyalty from analyzing raw purchase data stored in a database. So, whereas the present invention of claim 1 compares a set of classifications stored with the non-billing information in a database to an identical set of classifications stored with customer profiles in the database to match applicable non-billing information to each customer, *Jermyn* teaches analyzing purchases stored in a database to make a determination as to brand loyalty, and based on the analysis, sending applicable incentives to the consumers. *Jermyn* does not teach comparing loyalty classifications stored with the incentive profiles to loyalty classifications stored with the customer profiles, as would be required by claim 1 of the present invention. *Jermyn* does not teach storing loyalty determinations in the database at all, particularly with customer profiles and with incentive profiles.

The December 3, 2003 Office Action suggests that the product categories of *Jermyn* are equivalent to the classifications of non-billing information of the present invention. The applicants respectfully disagree. If the product categories represent non-billing information classifications, then *Jermyn* must teach that the incentives (representing the non-billing information) are stored in the database along with product categories as well as customer profiles stored with product categories. *Jermyn* does not teach this. Like the loyalty determinations discussed above, product categories are not stored in the database taught by *Jermyn*, only customer identification along with specific product purchases on specific dates.

The December 3, 2003 Office Action suggests that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the bill presentment system of *Remington* by scanning the billing information in the database of *Remington* in order to select products the user has purchased in the past, then match these products with non-billing information as taught by *Jermyn*. *Jermyn* pertains to the use of data mining techniques to analyze large quantities of raw data. *Remington*, on the other hand, relates to a generic system for billing customers for any type of service or product. A combination of the two references would be based solely on hindsight reasoning, as there is no suggestion in either reference of the desirability of combining them.

Even if combined in the manner suggested by the Office Action, the combination of *Remington* and *Jermyn* does not result in the invention of independent claim 1. As previously discussed, *Jermyn* uses large scale data mining of raw purchase data to determine how loyal a

customer has been to a selected brand of product, in contrast to storing customer classifications with the customer profiles and again with non-billing information profiles and then selecting targeted non-billing information for each customer according to classification matches from the two profiles. For at least these reasons, independent claim 1, as amended, is allowable over *Remington* in view of *Jermyn*.

#### Dependent Claim 4

Claim 4 was rejected under 35 U.S.C. § 103(a) as being obvious over *Remington* in view of *Jermyn*. *Remington* in combination with *Jermyn* does not teach, suggest, or describe each recitation of amended dependent claim 4. In particular, *Remington* and *Jermyn* fail to teach “recording said applicable classifications in respective customer profiles in said database; assigning applicable classifications from said set of classifications to selected non-billing information; and recording said applicable classifications in respective non-billing information profiles in said database.” As discussed above, *Jermyn* does not teach recording classifications with the customer profiles and with the non-billing information profiles within a database. Accordingly, for this reason, and because claim 4 depends from allowable independent claim 1, dependent claim 4 is allowable over *Remington* in view of *Jermyn*.

#### Independent Claim 10

Claim 10 was rejected under 35 U.S.C. § 102(b) as being anticipated by *Remington*. *Remington* does not teach, suggest, or describe each recitation of amended independent claim 10. In particular, *Remington* does not teach “a customer table, wherein said customer table comprises customer information, unique customer identifiers, and classifications assigned to customers; a billing information table, wherein said billing information table comprises unique customer identifiers and customer billing information, and has a relationship to said customer table based on said unique customer identifiers; a non-billing information table, wherein said non-billing information table comprises non-billing information and classifications assigned to said non-billing information, and has a relationship to said customer table based on said classifications; and a report that combines billing information for a customer with non-billing information that possesses an assigned classification matching an assigned classification of said customer, to

create said customized communication for said customer” as recited by amended independent claim 10. As discussed with reference to independent claim 1, *Remington* fails to teach storing customer classifications with non-billing information and with customer information in a database. Consequently, *Remington* also fails to teach storing this information in tables within the database. For at least this reason, independent claim 10 is allowable over *Remington*.

Additionally, the applicants submit that amended independent claim 10 is not obvious in view of *Jermyn*. *Jermyn* also fails to teach, suggest, or describe the recitations of claim 10. *Jermyn* fails to teach “a relational database system comprising: a customer table, wherein said customer table comprises customer information, unique customer identifiers, and classifications assigned to customers; a billing information table, wherein said billing information table comprises unique customer identifiers and customer billing information, and has a relationship to said customer table based on said unique customer identifiers; a non-billing information table, wherein said non-billing information table comprises non-billing information and classifications assigned to said non-billing information, and has a relationship to said customer table based on said classifications; and a report that combines billing information for a customer with non-billing information that possesses an assigned classification matching an assigned classification of said customer, to create said customized communication for said customer.”

As discussed above, *Jermyn* fails to teach classifications stored in a database with customer profiles and also with non-billing information profiles. Consequently, *Jermyn* fails to teach these two profiles with corresponding classifications and billing information as three separate tables within a database. For at least these reasons, as well as those discussed above with respect to independent claim 1, independent claim 10 is allowable over *Remington* in view of *Jermyn*.

#### Dependent Claims 12-13 and 15

Claims 12-13 and 15 were rejected under 35 U.S.C. § 103(a) as being obvious over *Remington* in view of *Jermyn*. *Remington* in combination with *Jermyn* does not teach, suggest, or describe each recitation of dependent claims 12-13 and 15. In particular, *Remington* and *Jermyn* fail to teach “a set of classifications correlated to customer traits,” “wherein applicable classifications are assigned to customers and said non-billing information,” and “wherein said

computer readable media further comprises instructions for assigning applicable classifications to customers and said non-billing information” as recited in claims 12-13 and 15. As discussed above, the cited references fail to teach classifications assigned to both customers and non-billing information. Accordingly, for at least this reason, and because claims 12-13 and 15 depend from allowable independent claim 10, dependent claims 12-13 and 15 are allowable over *Remington* in view of *Jermyn*.

Dependent Claims 7-9, 11, and 18-20

Because *Remington* in combination with *Jermyn* fails to teach, suggest, or describe the recitations of claims 7-9, 11, and 18-20 and because claims 7-9, 11, and 18-20 depend from allowable independent claims 1 and 10, dependent claims 7-9, 11, and 18-20 are allowable over *Remington* in view of *Jermyn*.

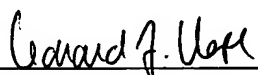
Conclusion

In view of the foregoing amendments and remarks, this application is now in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is invited to call the Applicants’ attorney at the number listed below.

Respectfully submitted,

MERCHANT & GOULD

Date: March 3, 2004

  
\_\_\_\_\_  
Leonard J. Hope  
Reg. No. 44,774

Merchant & Gould  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
Telephone: 404.954.5100

